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10/653,217	09/03/2003	Masanori Satake	116969	2607
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/653,217

## Applicant(s)

SATAKE ET AL.

## Examiner

Zachary A. Davis

## Art Unit

2137

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 20080311
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A response to the notice of non-responsive amendment was received on 11 March 2008. By this response, Claims 1 and 19 have been amended. No claims have been added or canceled. Claims 14-18 were previously withdrawn as drawn to a nonelected invention. Claims 1-13 and 19 are currently under examination in the present application.

### ***Election/Restrictions***

2. Applicant asserts that the election in the reply filed on 27 July 2007 was with traverse because of the argument therein that the search and examination of the entire application could be made without serious burden (see page 9 of the present response). However, the Examiner maintains that, in making the assertion in that previous reply that the search could be made without serious burden, Applicant did not cite any evidence in support of the assertion that the search could be made without serious burden, nor did Applicant provide any explanation other than that "the subject matter of all claims is sufficiently related" (see page 1 of the response received 27 July 2007). Therefore, that assertion amounted to a general allegation that the search would not cause a serious burden. Further, Applicant asserts that the Office did not meet its burden in levying the requirement for restriction (pages 9-10 of the present response). The Examiner respectfully disagrees, noting that the Examiner previously set forth both

why the inventions were considered to be independent or distinct (see pages 2-3, paragraph 4, of the restriction requirement mailed 16 July 2007) and why there would be a serious burden, namely the different classification of the inventions (see pages 2-3, paragraphs 3 and 5, of the restriction requirement). See MPEP §§ 808, 802, and 803. Applicant did not specifically address either of these showings in the reply filed on 27 July 2007. It is noted that "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification" (see MPEP § 803; see also MPEP § 808.02), and therefore, the Examiner met this requirement (again, see pages 2-3 of the restriction requirement). Further, the Examiner again notes that 37 CFR 1.142(a) indicates that a requirement for restriction "may be made at any time before final action" and was therefore timely in the present application. See MPEP § 811.

3. In summary, therefore, the Examiner again acknowledges Applicant's election of Group I, Claims 1-13 and 19, in the reply filed on 27 July 2007. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 14-18 remain withdrawn as noted above.

### ***Response to Arguments***

4. Applicant's arguments filed 11 March 2008 have been fully considered but they are not persuasive.

Applicant's arguments regarding the requirement for restriction (pages 9-10 of the present response) were addressed above. Applicant's arguments regarding the objections to the disclosure and Claim 13 and the rejection under 35 U.S.C. 112, second paragraph, see pages 10-11 of the present response, are addressed below under the corresponding headings.

Regarding the rejection of Claims 1-13 and 19 under 35 U.S.C. 103(a) as unpatentable over Jin, Korean Patent Application Publication KR 1993-0008657, in view of Hutchison, US Patent Application Publication 2003/0145218, Applicant argues that the cited prior art does not disclose the newly added claim limitation in independent Claim 1 of "a job controller for permitting execution of a following job without waiting for completion of deletion of the part of the job data file stored in the first storage device when the part of the job data file stored in the second storage device is deleted by the deletion controller" and a similar limitation in Claim 19 (pages 11-12 of the present response). However, the Examiner respectfully disagrees. First, the Examiner notes that there does not clearly appear to be explicit support for this new limitation in the present specification, and Applicant has not pointed out where the new limitations are supported. Therefore, the claims are rejected under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement, as set forth below. Second, the Examiner submits that the use of the language "permitting execution" does not clearly limit the claimed subject matter; although the claimed controller or method may "permit" an action to happen, this is not equivalent to the action actually being performed. Therefore, the Examiner submits that because the combination of Jin and

Hutchison does have a job controller (see Hutchison, paragraphs 0015, 0016, and 0019), it meets this limitation because there is a controller and it permits (i.e. does not prohibit) the action (execution of a following job) to occur. Finally, and alternately, if the language were considered to be limiting, the Examiner submits that the claims would still be rendered obvious by the combination of Jin and Hutchison. Specifically, it would appear that there are only a finite number of orders in which the actions of deletion of data and execution of jobs could be completed (assuming a finite number of actions to be performed). That is, primarily, a next job could be executed immediately after its preceding job (before any deletion occurred), the next job could be executed after the preceding job was entirely deleted, or the next job could be executed after part of the preceding job was deleted (and the remainder of the job deleted following that execution). Because there are a limited number of options, the Examiner submits that it would have been obvious to try the different orderings, and one of ordinary skill in the art would have used the ordering that provided the desired characteristics.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

### ***Drawings***

5. The objection to the drawings for informalities is withdrawn in light of the amended drawings received 11 March 2008.

***Specification***

6. The objection to the abstract is withdrawn in light of the amendments thereto. The objection to the disclosure for informalities is NOT withdrawn. Although Applicant has addressed some of the errors previously noted, Applicant asserts that other issues do not need to be addressed, because "there is nothing objectionable in the specification being any of vague, informal, or narrative" (page 10 of the present response). However, the Examiner respectfully disagrees, noting that 37 CFR 1.71(a) states that the description in the specification must be in "full, clear, concise, and exact terms" (i.e. not vague, informal, or narrative). See also MPEP § 608.01.

7. The disclosure is objected to because of the following informalities:

The specification appears to contain minor typographical and other errors. For example, on page 5, line 15, the phrase "deciding a volume of data stored in a RAM" is generally vague. On page 10, line 28, the phrase "The way of thinking is that..." is generally informal and narrative, and further is somewhat unclear in its phrasing. On page 17, lines 10-11, the phrase "The fundamental way of thinking behind this calculation is as follows" is generally informal and narrative.

Appropriate correction is required. Again, the above is not to be considered an exhaustive list of errors in the specification. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is again requested in correcting any errors of which applicant may become aware in the specification.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Independent Claims 1 and 19 have been amended to include the limitation "a job controller for permitting execution of a following job without waiting for completion of deletion of the part of the job data file stored in the first storage device when the part of the job data file stored in the second storage device is deleted by the deletion controller" and "permitting execution of a following job without waiting for completion of deletion of the part of the job data file stored in the first storage device when the part of the job data file stored in the second storage device is deleted", respectively. Applicant has not pointed out where the amended claims are supported, nor does there appear to be sufficient antecedent basis for the new claim limitation, noted above, in application as filed.

### ***Claim Objections***

9. The objection of Claim 13 under 37 CFR 1.75(c) for failure to further limit a previous claim is NOT withdrawn. Although Applicant asserts that deciding the size of the job data distributed further limits the subject matter of Claim 1, which only recites distributing the parts between the two storage devices based on available space in the second device (see page 11 of the present response). However, the Examiner disagrees that this further limits Claim 1. In particular, if the parts that are distributed to



the second storage device are decided based on the available space of the second storage device as in Claim 1, it appears that the size of those parts of the job data must necessarily be decided, especially given that the parts distributed are decided based on the available space. Although the language is not exactly the same, it appears that the limitations of Claim 13 are already required by Claim 1, and therefore Claim 13 does not further limit Claim 1.

10. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 recites that the size of the job data distributed to the second storage device is based on an amount of free space in the second device, but Claim 1 also recites that the distribution is based on available space in the second device.

***Claim Rejections - 35 USC § 112***

11. The rejection of Claims 1-13 under 35 U.S.C. 112, second paragraph, as indefinite is NOT withdrawn. Although some of the issues raised in the previous Office action have been addressed, other issues remain, and the amendments to the claims have raised further issues of indefiniteness, as set forth below. Further, the claims are additionally rejected under 35 U.S.C. 112, first paragraph, in light of the amendments to the claims.

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12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-13 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent Claim 1 has been amended to include the limitation "a job controller for permitting execution of a following job without waiting for completion of deletion of the part of the job data file stored in the first storage device when the part of the job data file stored in the second storage device is deleted by the deletion controller". Independent Claim 19 has similarly been amended to include the limitation "permitting execution of a following job without waiting for completion of deletion of the part of the job data file stored in the first storage device when the part of the job data file stored in the second storage device is deleted". Applicant has not pointed out where the amended claims are supported, nor does there appear to be a written description of the new claim limitation, noted above, in application as filed. See MPEP § 2163.04. See also MPEP § 2173.05(i) regarding negative limitations in general.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite the limitation "on a second storage device" in lines 10-11 of the claim. However, it is not clear that this is intended to refer to the same second storage device previously recited in the claim, although this appears to be likely. Further, the claim still recites "the part" in line 10 of the claim, in the phrase "the part of the job data file stored on a second storage device". The limitation in lines 6-8 recites that the job data file is divided into a plurality of parts that are distributed between the first and second storage device, which suggests that there may be more than one part stored on each of the first and second devices. If there is more than one part stored on the second device, then the limitation "the part of the job data file stored on a second storage device" is unclear, because it is not clear to which of the multiple parts this is intended to refer. Further, although the claim now recites "a part stored on the second storage device" in lines 8-9, this does not preclude the possibility of there being other parts stored on the second storage device. This renders the claim indefinite. Additionally, the claim now also recites "the part of the job data file stored in the first storage device" in line 14 and "the part of the job data file stored in the second storage device" in line 15. Again, if there is more than one part stored in each device, then it is not clear to which of these parts these limitations are intended to refer.

Claim 12 recites the limitation "a job controller"; it is not clear whether this is the same job controller as now recited in Claim 1. Further, if it is the same job controller,

then the limitation in Claim 12 that execution of the next job at the time of completion of data deletion processing is permitted appears to contradict the limitation in Claim 1 that execution of a following job is permitted without waiting for completion of deletion.

Claim 19 has been amended to recite the limitations "the part of the job data file stored in the first storage device" and "the part of the job data file stored in the second storage device" in lines 9-10. There is insufficient antecedent basis for these limitations as a whole in the claim. There is also insufficient antecedent basis for the limitation "the job data file".

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin, Korean Patent Application Publication KR 1993-0008657, in view of Hutchison, US Patent Application Publication 2003/0145218.

In reference to Claims 1 and 13, Jin discloses a device having a first storage device and a second storage device capable of having stored data erased at a faster

speed than the first storage device (see abstract, where there is a memory and a hard disk or floppy disk) and a storage controller that divides a job data file into a plurality of parts and distributes the parts between the first and second storage devices where data stored on the second storage device is not stored on the first device (see abstract). However, Jin does not explicitly disclose a deletion controller for deleting the part of the file stored on the second storage device or a job controller.

Hutchison discloses a job processing device having a storage controller that stores a job data file on a storage device (paragraph 0019), a deletion controller that deletes at least part of the data file when a prescribed deletion condition is satisfied (paragraph 0019 and 0031-0036), and a job controller permitting execution of a following job (paragraphs 0015, 0016, 0019, and 0031-0036). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Jin to include the deletion controller of Hutchison, in order to aid in protection of the print data (see Hutchison, paragraph 0003; see also paragraph 0031).

In reference to Claim 2, Jin and Hutchison further disclose a job data reconstructor that reconstructs the distributed data files (Jin, abstract) and a job processing unit that executes jobs based on job data (Hutchison, paragraph 0016), where completion of the job execution is the prescribed deletion condition (Hutchison, paragraph 0019).

In reference to Claims 3 and 4, Jin and Hutchison further disclose the second storage device being volatile memory or an area of the main storage device (Jin, abstract; Hutchison, paragraphs 0015 and 0019).

In reference to Claim 5, Jin and Hutchison further disclose encrypting the job data before distributing the data (Jin, abstract; Hutchison, paragraph 0020).

In reference to Claims 6-8, Jin and Hutchison further disclose distributing the job data according to a rule that can be changed according to the state of the job processing device or an attribute of the job (Jin, abstract; see also Hutchison, paragraphs 0028, and 0031-0036).

In reference to Claim 9, Jin and Hutchison further disclose deleting remaining job data after deleting part of the job data (Hutchison, paragraphs 0019; 0031-0036).

In reference to Claims 10 and 11, Jin and Hutchison further disclose that the deletion condition can be receipt of a job deletion instruction or a halt job execution instruction from a user (Hutchison, paragraphs 0019 and 0031-0036).

In reference to Claim 12, Jin and Hutchison further disclose permitting execution of the next job at the time of completion of deletion processing (Hutchison, paragraphs 0015, 0016, and 0019).

Claim 19 is directed to a method that corresponds substantially to the device of Claim 1, and is rejected by a similar rationale.

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ZAD/  
Examiner, Art Unit 2137

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2137